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APR 20 2010

OFFICE OF PETITIONS

In re Application of	:	
Toyomura, et al.	:	
Application No. 09/963,569	:	DECISION ON APPLICATION
Filed: September 27, 2001	:	FOR
Atty Docket No.00862.022392	:	PATENT TERM ADJUSTMENT

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT AND REQUEST UNDER 37 C.F.R. § 1.705(b)," filed June 11, 2009. Applicants request that the initial Determination of Patent Term Adjustment under 35 U.S.C. 154(b) be corrected from four hundred and five (405) days to one thousand, four hundred and twenty-one (1,421) days.

The application for patent term adjustment is **GRANTED TO THE EXTENT INDICATED HEREIN.**

The Office has updated the PALM and PAIR screens to reflect that the patent term adjustment determination at the time of the mailing of the notice of allowance is **five hundred and four (504) days**. A copy of the updated PAIR screen, showing the corrected determination, is enclosed.

On April 30, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 405 days. Applicants timely filed the instant application for patent term adjustment.¹

Applicants dispute the reduction of 100 days for applicant delay in responding to the restriction/election requirement mailed September 24, 2003. Applicants explain that applicants originally submitted the reply on October 20, 2003. Applicants

¹ PALM finance records indicate the issue fee was paid on June 18, 2009.

indicate that a petition to withdraw the holding of abandonment was filed on April 2, 2004, accompanied by a copy of the previously filed reply and a copy of the Office date-stamped postcard whereby the Office acknowledged having received the reply on October 20, 2003. Applicants maintain that the Office construed the petition to withdraw the holding of abandonment as the reply to the restriction/election requirement and entered a period of reduction of 100 days. Applicants assert that the petition to withdraw the holding of abandonment was not reply to the restriction/election requirement and that applicants filed a reply to the restriction/election requirement on October 20, 2003, within three months of the mailing date of the restriction/election requirement. Applicants conclude that it is, therefore, improper to enter a period of reduction to the patent term adjustment of 100 days.

Applicants' argument is well taken and is supported by a review of the file record. This conclusion is not based upon applicants' argument that the Office calculated that period of reduction under 37 CFR 1.704(b) using the date the petition to withdraw the holding of abandonment was filed. Rather, it is because applicants filed a complete response within three months of the September 24, 2003, mail date of the restriction/election requirement, as evidenced by the Office date stamped postcard dated October 20, 2003. Thus, applicants did not fail to engage in reasonable efforts to conclude processing by delaying in responding to the restriction/election requirement. Accordingly, the period of reduction of 100 days is not warranted and is being removed.

It is noted that a restriction/election requirement in response to the reply received October 20, 2003, was not mailed until August 27, 2007. 37 CFR 1.703(a)(2) provides that:

The period of adjustment under § 1.702(a) is the sum of the following periods:

The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing if either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, which ever occurs first[.]

Accordingly, the period of Office delay pursuant to 37 CFR 1.703(a)(2) began February 21, 2004, and ended on August 27, 2007, with the mailing of the restriction/election requirement.

Thus, the period of adjustment of 1,120 will be removed and a period of adjustment of 1,284 days will be entered for Office delay pursuant to 37 CFR 1.703(a)(2).

It is further noted that applicants dispute the reduction to the patent term adjustment of 916 days. Specifically, applicants state that:

It is also respectfully submitted that the USPTO incorrectly assessed an Applicant-delay period of 916 days for the period between the filing of the Information Disclosure Statement on October 5, 2006 and the filing of the Requested on April 2, 2004. Applicants cannot identify any failures to engage in reasonable efforts to conclude prosecution during this 916 period. The Notice of Abandonment was timely petitioned within the two months specified under 37 C.F.R. 1.181(f). Although the Decision acknowledged that the Request was filed on April 2, 2004, the Decision indicated that the Request was not received in the Office of Petitioners until the time of writing the Decision...there was no delay associated with the filing of the Information Disclosure Statement on October 5, 2006. Accordingly, it is respectfully submitted that the assessment of the 916 day period of Applicant-delay is incorrect.

Excerpt taken from "Application for Patent Term Adjustment and Request Under 37 C.F.R. 1.705(b) to Reconsider Patent Term Adjustment", filed June 11, 2009, page 5.

Applicants' argument has been considered but is not persuasive. A review of the application history reveals that Information Disclosure Statements were filed on May 16, 2005, June 30, 2006, and October 5, 2006, after a reply to the restriction/election requirement was filed on October 20, 2003. The record does not support a conclusion that the examiner expressly requested the filing of any of these Information Disclosure Statements. Further, a review of the above noted Information Disclosure Statements, reveals that applicants did not include a statement under 37 CFR 1.704(d).² Thus, applicants failed to engage in reasonable efforts to conclude prosecution of the application.

² Pursuant to 37 CFR § 1.704(d):

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs

Accordingly, pursuant, to 37 CFR 1.704(c)(8), it is appropriate to calculate the reduction to the patent term adjustment for these filings as 574 days for the IDS filed May 16, 2005, counting the number of days beginning on the day after the date the initial reply was filed, October 21, 2003, and ending on the date that the IDS was filed, May 16, 2005; 984 days for the IDS filed June 30, 2006, counting the number of days beginning on the day after the date the initial reply was filed, October 21, 2003, and ending on the date that the IDS was filed, June 30, 2006, and 1,081 days for the IDS filed October 5, 2006, counting the number of days beginning on the day after the date the initial reply was filed, October 21, 2003, and ending on the date that the IDS was filed, October 5, 2006. It is noted that the calendar days of the 574-day and 984-day periods of reduction overlap with the calendar days for the 1,081-days of reduction. It is appropriate, therefore, to only enter a period of reduction of 1081 days. Accordingly, the period of reduction of 916 days is being removed and the period reduction of 1,081 days is being entered.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is five hundred and four (504) days (1,585 (301 + 1,284) days of Office delay - 1,081 days of applicant delay).

The \$200.00 fee set forth in 37 CFR 1.18(e) was received on June 11, 2009. No additional fees are required.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

Telephone inquiries specific to this matter should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.

A handwritten signature in black ink, appearing to read 'Anthony Knight', with a stylized flourish at the end.

Anthony Knight
Director
Office of Petitions

Enclosure: Copy of REVISED PAIR Screen

Day : Monday
Date: 4/19/2010

PALM INTRANET

Time: 15:35:02

PTA Calculations for Application: 09/963569

Application Filing Date:	09/27/2001	PTO Delay (PTO):	1421
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	1016
Post-Issue Petitions:	0	Total PTA (days):	504
PTO Delay Adjustment:	99		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
89	04/19/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	99		
77	05/12/2009	MAIL NOTICE OF ALLOWANCE			
76	04/28/2008	ISSUE REVISION COMPLETED			
75	04/28/2009	DOCUMENT VERIFICATION			
74	05/12/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
73	05/12/2009	NOTICE OF ALLOWABILITY			
72	05/12/2009	DATE FORWARDED TO EXAMINER			
71	04/13/2009	SUPPLEMENTAL RESPONSE			
65	04/28/2009	CASE DOCKETED TO EXAMINER IN GAU			
63	03/11/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
62	04/13/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
61	04/13/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
60	03/31/2009	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
59	03/26/2009	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
58	03/11/2009	ELECTRONIC INFORMATION DISCLOSURE STATEMENT			
57	03/18/2009	DATE FORWARDED TO EXAMINER			
56	03/11/2009	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
55	03/18/2009	DATE FORWARDED TO EXAMINER			
54	03/11/2009	REQUEST FOR CONTINUED EXAMINATION (RCE)			

53	03/18/2009	DISPOSAL FOR A RCE / CPA / R129			
52	03/11/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
51	03/11/2009	WORKFLOW - REQUEST FOR RCE - BEGIN			
50	12/11/2008	MAIL FINAL REJECTION (PTOL - 326)			
49	12/08/2008	FINAL REJECTION			
48	09/28/2008	DATE FORWARDED TO EXAMINER			
47	09/03/2008	RESPONSE AFTER NON-FINAL ACTION			
46	06/03/2008	MAIL NON-FINAL REJECTION			
45	05/30/2008	NON-FINAL REJECTION			
44	04/09/2008	DATE FORWARDED TO EXAMINER			
43	02/19/2008	RESPONSE AFTER EX PARTE QUAYLE ACTION			
42	01/28/2008	MAIL EX PARTE QUAYLE ACTION (PTOL - 326)			
41	01/22/2008	EX PARTE QUAYLE ACTION			
36	11/15/2007	DATE FORWARDED TO EXAMINER			
35	11/01/2007	RESPONSE TO ELECTION / RESTRICTION FILED			
34	11/01/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
33	08/27/2007	MAIL RESTRICTION REQUIREMENT	1120		30
32	08/20/2007	REQUIREMENT FOR RESTRICTION / ELECTION			
31	07/19/2007	DATE FORWARDED TO EXAMINER			
30	04/02/2004	RESPONSE TO ELECTION / RESTRICTION FILED		100	15
29	07/20/2007	MAIL NOTICE OF RESCINDED ABANDONMENT			
28	06/30/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
27	06/30/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
26	07/06/2007	NOTICE OF RESCINDED ABANDONMENT IN TCS			
25	10/05/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
24	10/05/2006	REFERENCE CAPTURE ON IDS			
23.7	10/05/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		916	30
23	10/05/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
22	07/13/2006	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
21	06/19/2006	MAIL-PETITION TO REVIVE APPLICATION -			

		GRANTED			
20	04/02/2004	PETITION ENTERED			
19	05/16/2005	REFERENCE CAPTURE ON IDS			
18.7	05/16/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
18	05/16/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
17	03/15/2004	MAIL ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION			
16	03/08/2004	ABAND. FOR FAILURE TO RESPOND TO O. A.			
15	09/24/2003	MAIL RESTRICTION REQUIREMENT	301		-1
14	09/22/2003	REQUIREMENT FOR RESTRICTION / ELECTION			
13.7	01/29/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
13	01/29/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
12	07/30/2002	CASE DOCKETED TO EXAMINER IN GAU			
11	01/08/2002	REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED)			
10.7	01/08/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
10	01/08/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9.7	12/27/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9	12/27/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
8	06/12/2002	CASE DOCKETED TO EXAMINER IN GAU			
7	01/04/2002	APPLICATION DISPATCHED FROM OIPE			
6	01/04/2002	APPLICATION IS NOW COMPLETE			
5	10/26/2001	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
3	10/24/2001	CORRESPONDENCE ADDRESS CHANGE			
2	10/02/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	09/27/2001	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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